

REMARKS

1. Amendments and support therefor

Four claims (10, 14, 26, and 27) have been cancelled, four new claims (28-31) have been added, and claims 5-9, 11-13, and 15-25 have been amended to leave claims 5-9, 11-13, 15-25, and 28-31 in the application. Dependent claims 6-9, 11-13, and 15-17 ultimately depend from independent claim 1; dependent claims 19-21 and 28 ultimately depend from independent claim 18; dependent claims 23-25 ultimately depend from independent claim 22; and dependent claims 29-31 ultimately depend from independent claim 28. No fees should be due for the newly-added claims because four claims were cancelled (including independent claim 27) and four claims were added (including independent claim 28), resulting in a total of twenty three claims (four of which are independent). No new matter has been added by the amendments or new claims. For example, the independent and new claims find support as follows:

- Claim 1: amended for clarity of language, incorporating matter supported by, e.g.: page 13, line 13 to page 14, line 26; **FIGS. 6A, 6B, 7, and 8.**
- Claim 18: amended for clarity of language, incorporating matter supported by, e.g., **FIGS. 6A, 6B, 7, and 8.**
- Claim 22: amended for clarity of language, incorporating matter supported by, e.g.: page 13, line 13 to page 14, line 26; page 13, line 13 to page 14, line 26; **FIGS. 6A, 6B, 7, 8, and 9.**
- New claim 28: incorporates matter supported by, e.g., page 13, lines 13-23.
- New claim 29: incorporates matter supported by, e.g.: claims 1, 16, and 18; **FIGS. 6A, 6B, 7, and 8.**
- New claim 30: incorporates matter supported by, e.g.: claim 13; page 13, line 23 to page 14, line 26.
- New claim 31: incorporates matter supported by, e.g., **FIG. 6B.**

2. Pages 2–6 of the Office Action: Rejections Under 35 U.S.C. §103

Claims 5-27 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Russell* (US7000360) in view of *Kartfilt* (US4852323).

a. Overview of *Russell*, *Kartfilt*, and the present invention

Russell is directed to a walkway pad **20** directly applied to roofing membranes **11** comprising an elastomeric pad with upper and lower surfaces **20**, **21** and a 100-percent solids tape **25** pre-applied to the lower surface of the pad **21**, prior to use in the field (see **FIGS. 1–3**). By applying the tape at the factory as part of the manufacturing operation, the pad remains relatively clean, and adhesion between the tape and the pad is enhanced because of the clean and controlled conditions. See *Russell* col. 4, lines 41-60.

Kartfilt is directed to a roof membrane fastening system for covering and securing a membrane on a roof deck (see **FIGS. 1–3**). Fastening system **1** includes a bonding pad **2**, an attachment washer or plate **3**, a fastener **4**, an adhesive **5**, and a covering membrane **13**. After securing bonding pads **2** at desired locations, a layer of adhesive **24** is applied to an exposed area **25** of the top surface **26** of each bonding pad **2** which surrounds attachment washer **3**. Adhesive **24** bonds the pads to the adjacent underside surface areas **27** of membrane **13** in overlying contact therewith after the membrane has been spread over the attached bonding pads.

The present invention is directed to a tape capable of bridging the gaps between modules of modular buildings. These gaps, which can be four or more inches wide, were in the past filled with filler material and bridged using unenforced tape. Without the filler material, the traditional tapes would sag into the gaps, breaking any seal that was formed by the tape between the modules. As an initial matter, neither *Russell* nor *Kurtfilt* is directed to bridging gaps between modules of modular buildings.

b. No reason to modify *Russell* by reinforcing tape of *Russell* according to *Kurtfilt*

The office action concedes that *Russell*, being proposed as the primary reference in this rejection, is deficient. However, the Examiner proposes to modify *Russell* using *Kurtfilt* to render the claims allegedly obvious.

Russell is directed to walkway pads that are affixed on a roof membrane to protect the roof membrane from foot traffic. See *Russell* col. 1, lines 21-29. As discussed above, the walkway pads are affixed to rubber sheets using a tape. The tape provides adhesion between the walkway pad and the rubber sheets of the roof membrane. There is no reason to reinforce the tape used to bond the walkway pads and the rubber sheets at least because: (1) the tape is only being used to provide adhesion; (2) any needed reinforcing function is provided by the walkway pad and/or the roof

membrane, not the tape; and (3) reinforcing the tape would provide no useful purpose because there is no risk of detrimental sagging of the tape into a gap. The references consequently cannot properly be combined to show a reinforced tape, much less a reinforcing layer embedded within an adhesive layer in accordance with the present invention.

c. Kurtfilt does not disclose a reinforcing layer embedded in an adhesive layer

Claim 5, for example, recites:

A tape for bridging gaps between building modules, the tape including:

- a. a tacky adhesive layer having a lower surface and an opposing upper surface; and
- b. a porous reinforcing layer embedded within the adhesive layer between the lower and upper surfaces thereof;

wherein the tape is configured to bridge a gap of four inches between building modules without sagging more than 0.5 inches.

By contrast, *Kurtfilt* discloses a flexible bonding pad **2** reinforced with a polyester fabric. See *Kurtfilt* col. 7, lines 17-20. Bonding pad **2** has adhesive **5** applied thereto, but it is not itself a tacky adhesive layer. See *Kurtfilt* **FIG. 2**. There is no polyester fabric or any other reinforcing layer embedded within the adhesive layer between the lower and upper surfaces thereof, as recited in claim 5. As such, even if for the sake of argument *Kurtfilt* could be combined with *Russell* as proposed, *Kurtfilt* fails to cure the deficiencies of *Russell*.

d. Neither Russell nor Kurtfilt discloses a tape configured to bridge a gap of four inches without sagging more than 0.5 inches

As discussed above, neither *Russell* nor *Kurtfilt* is directed to bridging gaps between modules of modular buildings. Moreover, neither the tape of *Russell*, nor the adhesive of *Kurtfilt*, is capable of bridging a gap (which may be, for example, up to four inches or more) between building modules without substantial sagging (sagging less than, for example, half an inch even with a gap as wide as four inches) at least because they do not include a reinforcing layer within an adhesive. As such, *Russell* and *Kurtfilt* do not individually or in combination show the features recited in the claims.

e. The claimed thicknesses of layers do provide an advantage, are used for a particular purpose, and do solve a stated problem

The office action, on page 5, alleges that it would have been an obvious matter of design choice to modify thicknesses of the alleged outer layer from 0.25-0.5 inches to 0.03-0.06 inches. As an initial matter, it is noted that changing the walkway pads of *Russell* from 0.25-0.5 inches to 0.03-

0.06 inches, approximately one-tenth as small, is going to significantly diminish the ability of the walkway pads to provide protection and support. Such a modification would run contrary to the teachings of the references.

Here, tapes in accordance with the present invention are designed to be easily transportable and conveniently usable in the field to bridge gaps between building modules. Their thickness helps the tape to not interfere with the building modules being sealed together. It also enhances the ability of the tape to be rolled into a roll of tape. They use less raw material (and thus are less costly to manufacture) while enhancing their functions. For at least these reasons, the claimed thicknesses do provide an advantage, are used for a particular purpose, and do solve a stated problem.

f. No prima facie case of obviousness has been established

For at least the above reasons, the cited references cannot render at least independent claim 5 obvious. Claims 6-9, 11-13, and 15-17 are patentable at least for the additional reason of their dependency, and because of the additional features recited therein. Independent claims 18 and 22 are patentable for reasons analogous to the above reasons. Claims 19-21 and 23-25 are patentable at least for the additional reason of their dependency, and because of the additional features recited therein.

The rejection of claims 10, 14, 26, and 27 are moot due to their cancellation.

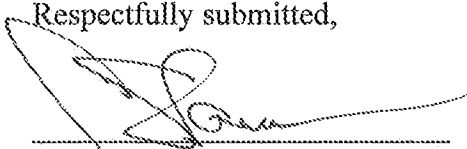
3. New Claims 28-31

New claims 28 and 29 are patentable at least for reasons analogous to those discussed above. Claims 28, 30, and 31 are also patentable at least as a result of their dependency, and because of the additional features recited therein.

4. In Closing

Should the Examiner have any questions or comments with respect to the application, the Examiner is requested to contact the undersigned attorney. The attorney welcomes and encourages telephone calls related to this application because this may allow the resolution of disputed claim language and/or other informalities more rapidly and efficiently than by any other means. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

Respectfully submitted,



Charles S. Sara, Reg. No. 30,492
CUSTOMER NO.: 25005
Intellectual Property Department
DEWITT ROSS & STEVENS S.C.
2 East Mifflin Street, Suite 600
Madison, WI 53703-2865
Telephone: (608) 255-8891
Facsimile: (608) 252-9243

I certify that this paper is being electronically submitted to the U.S. Patent and Trademark Office via the EFS-Web system on the following date:

Date of Electronic Submission: 12/20/2010

Signature: Shawn Baumann